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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,162	04/08/2004	David B. Sutton	PRIV 0104 PUS	9189
22045 7590 03/12/2007 BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER LIVERSEEDGE, JENNIFER L	
			ART UNIT	PAPER NUMBER
			3692	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/12/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/821,162

Applicant(s)

SUTTON ET AL.

Examiner

Jennifer Liversedge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/8/2004, 7/29/2004, 10/25/2005, 6/20/2006, 6/28/2006, 8/7/2006.

**DETAILED ACTION**

***Response to Amendment***

This Office Action is responsive to Applicant's amendment of application 10/821,162 filed on April 8, 2004.

The amendment contains new claims: 15-44.

Claims 1-14 have been canceled.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-19, 29-31 and 34-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The use of embossing and indicia is not described in the description and therefore may not be claimed subject matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 18-19, 29-31 and 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of embossing and indicia is not described in the description and therefore may not be claimed subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15-20, 22-29, 32-37 and 39-43 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,473,500 B1 to Risafi et al. (further referred to as Risafi).

Regarding claims 15-16 and 27, Risafi discloses a method of currency conversion (columns 1-20), comprising:

Receiving currency in a first amount from a consumer (column 6, lines 38-51);

Converting the currency into an electronic purchase card for use by the consumer, where the electronic purchase card having a value equal to the first amount

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less a service fee assessed by a provider of the purchase card (column 6, lines 38-67; column 10, lines 46-49; column 11, lines 61-63); and

Providing the electronic purchase card to the consumer, where the electronic purchase card enables the consumer to transact a purchase by the consumer at a retailer different than the provider of the purchase card (column 6, lines 38-67);

Wherein the electronic purchase card is a bearer instrument (column 6, lines 38-67; column 10, lines 46-49; column 11, lines 61-63).

Regarding claim 29, Risafi discloses a method of currency conversion (columns 1-20), comprising:

Receiving currency in a first amount from a consumer (column 6, lines 38-51);

Converting the currency into an electronic purchase card for use by the consumer, where the electronic purchase card having a value equal to the first amount less a service fee assessed by a provider of the purchase card (column 6, lines 38-67; column 10, lines 46-49; column 11, lines 61-63); and

Providing the electronic purchase card to the consumer, where the electronic purchase card enables the consumer to transact a purchase by the consumer at a retailer different than the provider of the purchase card (column 6, lines 38-67);

Claim 29 is rejected under 35 USC 112 as the use of indicia is not disclosed. However, Risafi discloses the use of multiple indicia on a prepaid card in order to designated affiliated parties (Figures 3a and 3b; column 11, lines 7-18).

Regarding claims 32-33, Risafi discloses a method of currency conversion (columns 1-20), comprising:

Receiving currency in a first amount from a consumer (column 6, lines 38-51);

Converting the currency into an electronic purchase card for use by the consumer (column 6, lines 38-67; column 10, lines 46-49; column 11, lines 61-63) the electronic card having an associated account number but does not identify the consumer (column 4, column 6, columns 10-11; Figures 3a-3c); and

Providing the electronic purchase card to the consumer, where the electronic purchase card is operable to transact a purchase by the consumer at a retailer different than the provider of the purchase card (column 6, lines 38-67);

Wherein the electronic purchase card is a bearer instrument (column 6, lines 38-67; column 10, lines 46-49; column 11, lines 61-63).

Regarding claims 17 and 28, Risafi discloses wherein the electronic purchase card has an associated account number but does not identify the consumer (column 4, column 6, columns 10-11; Figures 3a-3c).

Regarding claims 18-19 and 34-36, these claims are rejected under 35 USC 112 as the use of embossing and indicia is not disclosed. However, Risafi discloses the use of multiple indicia on a prepaid card in order to designated affiliated parties (Figures 3a and 3b; column 11, lines 7-18).

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Regarding claims 20, 22, 37 and 39, Risafi discloses activating the purchase card by contacting the provider of the purchase card prior to transacting a purchase over a network connection (Figure 2; column 4, lines 17-67; column 6, lines 37-67; column 11, lines 58-67).

Regarding claims 23 and 40, Risafi discloses where the purchase card enables the consumer to transact one or more purchases up to the value associated with the electronic purchase card (column 4; column 9, lines 26-50; column 10, lines 32-49; column 13, lines 41-52; column 20, lines 8-12).

Regarding claims 24-25 and 41-42, Risafi discloses transacting the conversion at a retail establishment where the electronic purchase card is provided to the retail establishment by the provider of the purchase card on consignment basis (column 2, column 4, column 6).

Regarding claims 26 and 43, Risafi disclose wherein the step of receiving currency and converting the currency is performed remotely from the consumer by the provider of the purchase card, such that the electronic purchase card is subsequently mailed to the consumer (column 9, lines 26-57).



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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 21, 30-31, 38 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi, and further in view of Official Notice.

Regarding claims 21 and 38, Examiner takes Official Notice that it is old and well known and therefore would have been obvious to one of ordinary skill in the art at the time of the invention to include contact information for the card provider on the card. Providing provider name, address(es), phone number, etc. is old and well known as a means of offering communication channels and locating those communication channels on the card for ease of use by the consumer.

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Regarding claims 30-31, Risafi discloses activating the purchase card by contacting the provider of the purchase card prior to transacting a purchase over a network connection (Figure 2; column 4, lines 17-67; column 6, lines 37-67; column 11, lines 58-67). Examiner takes Official Notice that it is old and well known and therefore would have been obvious to one of ordinary skill in the art at the time of the invention to include contact information for the card provider on the card. Providing provider name, address(es), phone number, etc. is old and well known as a means of offering communication channels and locating those communication channels on the card for ease of use by the consumer.

Regarding claim 44, Risafi discloses a method of currency conversion (columns 1-20), comprising:

Receiving currency in a first amount from a consumer (column 6, lines 38-51);

Converting the currency into an electronic purchase card for use by the consumer (column 6, lines 38-67; column 10, lines 46-49; column 11, lines 61-63) the electronic card having an associated account number but does not identify the consumer (column 4, column 6, columns 10-11; Figures 3a-3c); and

Providing the electronic purchase card to the consumer, where the electronic purchase card is operable to transact a purchase by the consumer at a retailer different than the provider of the purchase card (column 6, lines 38-67);

Activating the purchase card by contacting the provider of the purchase card prior to transacting a purchase (Figure 2; column 4, lines 17-67; column 6, lines 37-67; column 11, lines 58-67).

Examiner takes Official Notice that it is old and well known and therefore would have been obvious to one of ordinary skill in the art at the time of the invention to include contact information for the card provider on the card. Providing provider name, address(es), phone number, etc. is old and well known as a means of offering communication channels and locating those communication channels on the card for ease of use by the consumer.

### ***Conclusion***

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at 571-272-6777. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

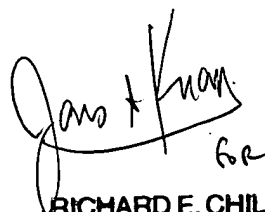
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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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A handwritten signature in black ink, appearing to read "R. E. Chilcot, Jr.", with a stylized flourish at the end.

RICHARD E. CHILCOT, JR.  
SUPERVISORY PATENT EXAMINER